

**AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3627
PATENT**

**ATTORNEY DOCKET NO. 2000P7518 US (1009-026)
SERIAL NO. 09/528,693**

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claims 1 and 2 have been amended for reasons unrelated to patentability, including at least one of: to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of claims of particular current licensing interest, to target one or more claims to a party currently interested in licensing certain embodiments, to enlarge the royalty base of one or more claims, to cover a particular product or person in the marketplace, to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, and/or to target one or more claims to a particular industry.

I. The Indefiniteness Rejection – Claims 1 and 2

Claims 1-6 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

According to MPEP § 2173.02 “[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available ... [s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire...” Based upon this standard, it is respectfully submitted that claims 1-6 as amended provide sufficient clarity and precision.

II. The Indefiniteness Rejection – Claim 6

Claim 6 was rejected under 35 U.S.C. §112. This rejection is respectfully traversed. Filed

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herewith is a 37 CFR § 1.132 Declaration of Dr. Ronald D. Williams, a professor of engineering at University of Virginia, and one skilled in the art of electrical engineering. Paragraphs 13-17 of Dr. Williams' Declaration establish that one skilled in the art would find sufficient structural elements for a "means of automatically interfacing to the Internet" in the applicant's specification.

Specifically, page 4 of the specification recites "an Internet **interface** 204 for **automatically interfacing to the internet** using the label retrieved from the memory 200"; "the **interface** is provided by a human/machine interface (HMI) such as that provided by Siemens"; "[t]he HMI provides a **software interface** to industrial-type processors such as PLCs"; and "an **internet interface** is provided **that automatically interfaces to the internet** using the label stored in memory 200".

Thus, one of ordinary skill in the art would recognize possible embodiments of an Internet interface from the support provided in the specification. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

III. The Anticipation Rejections

The 37 CFR § 1.132 Declaration of Dr. Ronald D. Williams, filed herewith, indicates that one skilled in the art would not find all of the elements and limitations of the claims present in any the cited references.

As explained below, the cited references fail to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in

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the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

A. The Rejection citing Cragun

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(b). In support of the rejection, Cragun et al. (U.S. Patent No. 5,804,803) was cited. This rejection is respectfully traversed.

Claim 1 cites “a **programmable logic controller, the programmable logic controller** couplable to a network.” Paragraphs 18-21 of Dr. Williams’ Declaration indicate that one skilled in the art would not find that Cragun teaches “a **programmable logic controller, the programmable logic controller** couplable to a network.” Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Cragun and should be withdrawn. In addition, the rejection of claims 2-6, each ultimately depending from independent claim 1, is unsupported by Cragun and should be withdrawn.

B. The Rejection citing Reber

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Reber et al. (U.S. Patent No. 5,940,595) was cited. This rejection is respectfully traversed.

Claim 1 cites “a **programmable logic controller, the programmable logic controller**

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couplable to a network.” Paragraphs 18-21 of Dr. Williams’ Declaration indicate that one skilled in the art would not find that Reber teaches “a **programmable logic controller**, the **programmable logic controller** couplable to a network.” Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Reber and should be withdrawn. In addition, the rejection of claims 2-6, each ultimately depending from independent claim 1, is unsupported by Reber and should be withdrawn.”

Moreover, Reber fails to properly establish inherent anticipation. See MPEP 2112. “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that admittedly the “missing descriptive material is ‘necessarily present’” in Reber. Accordingly, it is respectfully submitted that the rejection of claims 1-6 is unsupported by Reber and should be withdrawn.

IV. The Obviousness Rejection

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Cragun et al. (U.S. Patent No. 5,804,803) in view of Ohanian et al. (U.S. Patent No. 6,109,526). These rejections are respectfully traversed.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Hudetz et al. (U.S. Patent No. 5,978,773) in view of Ohanian et al. (U.S. Patent No. 6,109,526). These rejections are respectfully traversed.

As explained below, none of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

A. Cragun in view of Ohanian

Ohanian allegedly cites "the present invention embodies a data input apparatus that obtains information relative to a target. The apparatus includes a processor, a wireless data receiver, and an associated data capture engine. The wireless data receiver is coupled to the processor and receives electromagnetic data from at least one resonator, such as a dipole, positioned relative to the target. The data capture engine is also coupled to the processor and receives data from an associated data carrier, such as a machine-readable symbol..." See column 2 lines 10-19.

Claim 1, from which claims 2-6 depend, cites "a **programmable logic controller**, the **programmable logic controller** couplable to a network." Paragraphs 22-25 of Dr. Williams' Declaration indicate that one skilled in the art would find that neither Cragun nor Ohanian either alone or in combination teach "a **programmable logic controller**, the **programmable logic controller** couplable to a network."

Thus, even if combinable or modifiable, the cited references do not expressly or inherently teach or suggest **every** limitation of the claims. Accordingly, it is respectfully submitted that Cragun in view of Ohanian does not render obvious independent claim 1.

Consequently, reconsideration and withdrawal of the rejection of claims 1-6 is respectfully requested.

B. Ohanian in view of Hudetz

Hudetz allegedly cites “[a] system and method for using identification codes found on ordinary articles of commerce to access remote computers on a network. In accordance with one embodiment of the invention, a computer is provided having a database that relates Uniform Product Code (‘UPC’) numbers to Internet network addresses (or ‘URLs’). To access an Internet resource relating to a particular product, a user enters the product’s UPC symbol manually, by swiping a bar code reader over the UPC symbol, or via other suitable input means. The database retrieves the URL corresponding to the UPC code. This location information is then used to access the desired resource.” See Abstract.

Claim 1, from which claims 2-6 depend, cites “a **programmable logic controller**, the **programmable logic controller** couplable to a network.” Paragraphs 26-29 of Dr. Williams’ Declaration indicate that one skilled in the art would find that neither Hudetz nor Ohanian either alone or in combination teach “a **programmable logic controller**, the **programmable logic controller** couplable to a network.”

Thus, even if combinable or modifiable, the cited references do not expressly or inherently teach or suggest **every** limitation of the claims. Accordingly, it is respectfully submitted that Ohanian in view of Hudetz does not render obvious independent claim 1.

Consequently, reconsideration and withdrawal of the rejection of claims 1-6 is respectfully requested.

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V. Lexicography

Definitions referenced in paragraphs 25 and 26 of the present Office Action, dated 17 December 2003, are again respectfully traversed. As recognized in a previous Office Action, “[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.” *CCS Fitness Inc. v. Brunswick Corp.*, 288 F. 3d 1359, 1366 (Fed. Cir. 2002). Further:

When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)(“Words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”). See also, *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983)

See MPEP § 2111.01.

The Office Actions provide no documentary evidence linking the specific proffered definitions to “the ordinary meaning of claim language as understood by one of ordinary skill in the art”.

Paragraph 12 of the 37 CFR § 1.132 Declaration of Dr. Ronald D. Williams, filed herewith, however, does provide “the ordinary meaning” of the claim term “Programmable Logic Controller (PLC)” “as understood by one of ordinary skill in the art.”

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CONCLUSION


It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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